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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,340	12/03/2001	Kaoru Torikoshi	111243	5573

25944 7590 08/20/2004

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT PAPER NUMBER

1774

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/998,340	<b>Applicant(s)</b> TORIKOSHI, KAORU
	<b>Examiner</b> Betelhem Shewareged	<b>Art Unit</b> 1774

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Detailed Action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 4 and 15.

Claim(s) rejected: 1-3, 13 and 14.

Claim(s) withdrawn from consideration: 5-12.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's response filed on 05/11/2004 has been fully considered. Claims 1-15 are pending. Of pending claims 1-15, claims 5-12 are still withdrawn from consideration as non-elected invention.

### ***Claim Rejections - 35 USC § 102***

2. Claims 1-3, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Sarkar et al. (US 6,465,081 B2).

Sarkar discloses an image receptor sheet comprising a substrate having two opposite sides, an ink receptive layer on one side of the substrate, and an ink repellent layer on the other side of the substrate, wherein the ink repellent layer is toner powder receptive so as to allow the image receptor sheet to be used in electrophotographic printers (col. 3, lines 22-32). The side of the substrate that has the ink repellent layer is equivalent to the claimed side of the substrate that the electrophotographic image is being formed. The ink receptive layer is equivalent to the claimed characteristic controlling member. The substrate and the coated layers are transparent (col. 3, line 41 and claims 3 and 8). The ink receptive layer comprises resin and filler as the claimed characteristic controlling member (col. 5, line 60 thru col. 6, line 16). Since the ink receptive layer is substantially identical to the claimed characteristic controlling member, the layer inherently functions as glossiness controlling layer that reduces glossiness. Since all the three layers are transparent, an image that may be provided on the ink repellent toner receptive layer can be seen when viewed through the substrate.

***Response to Arguments***

3. Applicant's argument is based on that the ink receptive layer of Sarkar does not control glossiness. This argument is not persuasive for the following reason. The ink receptive layer is substantially identical to the claimed characteristic controlling member, i.e., the ink receptive layer of Sarkar comprises resin and filler as the claimed characteristic controlling member, thus the layer inherently functions as glossiness controlling layer that reduces glossiness. It is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Sarkar reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Applicant further argues that since the fillers of Sarkar do not compromise the transparency of the ink receptive layer, and also the fillers of Sarkar do not control the glossiness of the ink receptive layer. These arguments are not persuasive because Sarkar does not expressly disclose that the ink receptive layer *does not control glossiness*. However, because the ink receptive layer is substantially identical to the claimed characteristic controlling member (i.e., the fillers and the resin that are used to make the ink receptive layer are substantially identical to the fillers and the resin that are used to make the claimed characteristic controlling member of the claimed

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invention), the layer inherently functions as glossiness controlling layer. Furthermore, Applicant is advised to provide factual evidence showing that the addition of fillers in the ink receptive layer while not compromising the transparency of the layer does not affect the glossiness of the layer.

For the above reasons claims 1-3, 13 and 14 stand rejected.

***Allowable Subject Matter***

4. Claims 4 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Sarkar neither teaches nor suggests mechanical treatment of the surface of the substrate opposite the ink repellent toner receptive layer in order to control the glossiness of the image recording sheet.


***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Betelhem Shewareged', with a stylized, cursive script.

Betelhem Shewareged  
August 16, 2004.